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Re: Appeal No. 2005-2324
Application Serial No. 09/944,315

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Request for Rehearing (3 pages)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2005-2324
Appellant: M. Masters et al.
Serial No.: 09/944,315
For: Textured Surfaces for Hearing Instruments
Filed: August 31, 2001
Group: 2646
Examiner: Phylesha L. Dabney
Att'y Dkt.: 2001 P 16281 US

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Request for Rehearing

Board of Patent Appeals and Interferences
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A decision on appeal was rendered in this matter on August 31, 2005. The appellants request a rehearing on the grounds that (1) the claim construction in the decision on appeal does not take into account the viewpoint of the person skilled in the art and (2) the § 103 rejection lacks proper support.

This request is timely as it is being submitted within the 60-day period set forth in 37 C.F.R. § 41.52.

The Construction of the Claims is Contrary
to the Understanding of those Skilled in the Art

Although the decision states that a claim is construed "'in light of the specification as it would be interpreted by one of ordinary skill in the art'" (Decision on Appeal at 6), it does not discuss or deal with this requirement. In Phillips v. AWH Corporation, 415 F.3d 1303, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005), the Federal Circuit stated that the terms of the claim should be read in the context of the application.

> [T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.

415 F.3d at 1313, 75 U.S.P.Q.2d at 1326. Under this standard, the appellants' claims do not read on the cited references. See also In re Cortright, 165 F.3d 1353, 1358, 49 U.S.P.Q.2d 1464, 1467 (Fed. Cir. 1999) (the construction applied to a term must be

"consistent with the one that those skilled in the art would reach"); M.P.E.P. § 2111 (8th ed., rev. 3, Aug. 2005), page 2100-47 (last paragraph in the left-hand column); Reply Brief (pp. 1-2).

The Term "Texture" has not been Properly Construed

Those skilled in the art of designing and manufacturing devices that assist the hearing impaired would not understand the term "texture" -- when read in the context of the specification -- to mean reinforcing ribs (Widmer et al.) as they are clearly too large and widely spaced to be considered the "texture" defined in the application. Moreover, the reinforcing ribs illustrated in the reference would likely injure the user's ear canal. See Reply Brief, p. 3.

Moreover, Widmer et al. is concerned with strengthening the shell with reinforcing ribs that for the most part are situated on the inside of the shell, not on the outside surface. The Decision on Appeal relies in part on Figure 15, illustrating the inside of the hearing instrument (Decision on Appeal, p. 7) (see Widmer et al., column 3, lines 60-62). One skilled in the art would understand that the appellants are concerned with a problem involving only the outer surface of the shell and therefore Figure 15 is inapposite.

The Correct Standard has not been Discussed or Applied

What is missing from the discussion in the Decision on Appeal and the underlying office actions is the requirement -- noted in Phillips -- to read the terms in the context of the specification from the vantage point of those in the involved in designing and manufacturing hearing instruments. Instead, the Decision on Appeal is silent on this topic.

Construed in accordance with Phillips, the claims are of appropriate scope and do not read on the cited references. Nor would the disclosure of Widmer et al. "infringe" the appellants' pending claims had they issued before the effective dates of the reference.

The Skill in the Art alone does not Establish Obviousness

The Decision on Appeal asserts that the appellants did not contest the "taking of 'official notice.'" The appellants disagree. The appellants consistently challenged the examiner to provide a basis for the unsupported and merely conclusory statements that "it was well known." As set forth in the appellants' papers, "ordinary skill" alone is an insufficient basis for establishing obviousness. M.P.E.P. § 2143.01 (8th ed., rev. 3, Aug. 2005), p. 2100-135, citing Al-Site Corporation v. VSI International, Inc., 174 F.3d 1308, 1324, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999) ("[s]kill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case..."); Reply Brief, p. 4.

For example, the examiner's answer asserts that "it is known to include a textured faceplate onto [sic] a hearing instrument...." Examiner's Answer, p. 4, last paragraph. As this is a critical issue in the application, it was incumbent upon the examiner to provide evidence supporting this position. M.P.E.P. § 2144.03(C). The examiner failed to do this and, therefore, the rejection is not supported by adequate evidence and should be reversed.

Conclusion

For at least the foregoing reasons, the appellants request that the Board reconsider the decision on appeal and reverse the examiner.

Dated: October 24, 2005

Respectfully submitted,

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